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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,793	12/01/2000	Joseph Lerner	28961.011300	5692

22191 7590 02/23/2004

GREENBERG-TRAURIG  
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MCLEAN, VA 22102

EXAMINER
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PWU, JEFFREY C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 02/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/726,793

Applicant(s)

LERNER ET AL.

Examiner

Jeffrey Pwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### **Claim Rejections - 35 USC § 112**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 2 recites the limitation "all securities" and "the present invention" in claim 1.

There is insufficient antecedent basis for this limitation in the claim.

3. Claim 3 recites the limitation "the present invention" and "have yet to be sold off" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

4. Claim 8 recites the limitation "the accumulation of " in claim 6. There is insufficient antecedent basis for this limitation in the claim.

5. Claim 9 recites the limitation "as a result of" in claim 4. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 10 recites the limitation "the passing of" in claim 10(?). There is insufficient antecedent basis for this limitation in the claim.

7. Claim 11 recites the limitation "the accumulation of" in claim 10. There is insufficient antecedent basis for this limitation in the claim.

8. Claim 12 recites the limitation "other such shareholder" in claim 4. There is insufficient antecedent basis for this limitation in the claim.

**Claim Rejections - 35 USC § 102**

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being unpatentable over Wallman (US 6,338,047).

Wallman discloses:

An electronic system for creating personalized securities funds comprising:

- ◇ a user interface for receiving selections of securities to be included in a fund (investors 1-10; 110; figs.1-2b);
- ◇ a securities holding account (140; 180);
- ◇ a securities engine which calculates and tracks whole and fractional securities shares owned by an individual investor (claim 9);
- ◇ an accounting engine which calculates account balances (col.10, line 46-col.11, line 14); and
- ◇ a reporting engine which generates system-wide and individual investor reports (col.11, line 14-col.12, line 15).

Wallman further discloses:

A method for managing personalized securities funds comprising:

- ◇ electronically receiving a user's selection of a number of shares or a dollar amount of a given security to be purchased, sold, or transferred (investors 1-10; 110; figs.1-2b);

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- ◇ electronically consolidating and executing by and sell orders (110, 120; fig.1);
- ◇ electronically calculating whole and fractional shares owned along with fees, dividends, and proceeds of sale (130);
- ◇ reporting results of said calculations to said user (130); and
- ◇ wherein said consolidating and executing occurs in real time (col.6, lines 23-61).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey Pwu whose telephone number is 703 308-7835.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on 703 308-0505.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey Pwu  
Examiner  
Art Unit 3628



JEFFREY PWU  
PRIMARY EXAMINER